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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,157

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Wittich Kaule

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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WASHINGTON, DC 20005

EXAMINER

CALLAWAY, JADE R

ART UNIT

PAPER NUMBER

2872

NOTIFICATION DATE

DELIVERY MODE

03/20/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No. 10/565,157	Applicant(s) KAULE ET AL.	
	Examiner JADE CALLAWAY	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-75 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Preliminary Amendments to the Specification, Claims and Abstract, in the submission dated 1/19/06, are acknowledged and accepted.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-8, 13-47, 55-56, 58-60, 64-73, drawn to a security element, and a method of producing a security element, that has at least one area with a diffraction structure, which under specific viewing conditions reconstructs a diffractive image, wherein the area has subareas which do not take part in the reconstruction, characterized in that the information represented by the subareas is recognizable only under the specific viewing conditions of the diffractive image.

Group 2, claim(s) 9-12, 48-54, 61-63, drawn to a security element, and a method of producing a security element, which has at least one area with a diffraction structure, which under specific viewing conditions reconstructs a diffractive image, wherein the area has subareas which do not take part in the reconstruction, characterized in that the information represented by the subareas is recognizable only under viewing conditions differing from the specific viewing conditions of the diffractive image.

Group 3, claim(s) 57, 74-75, drawn to a method for producing a document of value by: producing a security element which has at least two areas with diffraction structures that each comprise a plurality of partial areas that are interlaced into each other.

3. The inventions listed as Groups 1-3 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

For each of Groups 1-3 above, each of the listed groups has special technical features not required for the other listed groups. The special technical features exclusive to each group are listed above in the listing of the groups.

4. **If Group 1 is elected the following restriction requirement applies:**

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1(a), claim(s) 4-5, 59, drawn to a security element with a transparent plastic layer.

Group 1(b), claims 6-7, drawn to a security element with subareas that form overprinted areas of the first reflection layer.

Group 1(c), claims 8 and 60, drawn to a security element with a metal layer.

Group 1(d), claims 13-14, drawn to a security element that has two adjoining areas.

Group 1(e), claims 15-25, 64-66, drawn to a security element that has a plurality of partial areas in at least one of the subareas.

Group 1(f), claim 26, drawn to a security element wherein the information is recognizable on at least one of rotating or tilting the element.

Group 1(g), claim 27, drawn to a security element wherein the area or areas are surrounded by a diffraction structure.

Group 1(h), claim 28, drawn to a security element wherein at least one of the areas has a diffraction structure with an asymmetric profile.

Group 1(i), claim 29, drawn to a security element wherein at least one of the areas has a rainbow hologram, a volume hologram or a grating structure

Group 1(j), claim 30, drawn to a security element wherein at least one of the areas is formed as an embossed structure.

Group 1(k), claims 31-37, 58, 67-70, drawn to items with a security element.

Group 1(l), claim 40, 43-45 and 71-72, drawn to method wherein a transparent plastic layer is embossed in the form of a relief structure.

Group 1(m), claims 41-42, drawn to a method wherein the subareas are produced by at least one of removing the first reflection layer or destroying the diffraction structure.

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Group 1(n), claims 46-47 and 73, drawn to a method wherein the subareas are produced by overprinting the first reflection layer with a neutralizing printing ink.

Group 1(o), claims 55-56, drawn to a method wherein at least two areas with diffraction structures are produced each comprising a plurality of partial areas that are interlaced into each other.

5. Claim 1 links Groups 1(a)-1(k). Claim 39 links Groups 1(l)-1(o). Claims 2-3 will be examined along with the elected invention of Group 1(a)-1(k).

6. The inventions listed as Groups 1(a)-1(o) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is a security element that has at least one area with a diffraction structure, which under specific viewing conditions reconstructs a diffractive image, wherein the area has subareas which do not take part in the reconstruction, characterized in that the information represented by the subareas is recognizable only under the specific viewing conditions of the diffractive image. This element cannot be a special technical feature under PCT rule 13.2 because the system is shown in the prior art. European Patent 1197350 (A3) teaches a security element substantially as claimed in claim 1 and 39.

7. If Group 2 is elected the following restriction requirement applies:

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 2(a), claims 49 and 52-54, drawn to a method wherein the diffraction structure is embossed into the form of a relief structure.

Group 2(b), claims 50-51, drawn to a method wherein the subareas are produced by removing the first reflection layer.

8. Claim 48 links Groups 2(a) and 2(b). Claims 9-12 and 61-63 will be examined along with the elected invention of 2(a)-2(b).

The inventions listed as Groups 2(a)-2(b) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is a method for producing a security element by:

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producing at least one area with a diffractive structure, which under specific viewing conditions reconstructs a diffractive image, producing sub areas which do not take part in the reconstruction, wherein the information represented by the subareas is recognizable under viewing conditions differing from the specific viewing conditions of the diffractive image. This element cannot be a special technical feature under PCT rule 13.2 because the system is shown in the prior art. European Patent 1197350 (A3) teaches a security element substantially as claimed in claim 48.

9. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention

11. A telephone call was made to George Repper (202-783-6040) on 3/14/08 to request an oral election to the above restriction requirement, but did not result in an election being made.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JADE CALLAWAY whose telephone number is (571)272-8199. The examiner can normally be reached on Monday to Friday 7:00 am - 4:30 pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRC

/Jade R. Callaway/

Examiner, Art Unit 2872

/Stephone B. Allen/

Supervisory Patent Examiner, Art Unit 2872